

REMARKS

Claims 66-84 are pending in the application and finally rejected. Reconsideration and allowance of claims 66-84 are respectfully requested. This Draft Request for Reconsideration is submitted in preparation for a telephone call between the Examiner and the undersigned attorney scheduled for Tuesday, September 19, 2006 at 4:00 PM EDT, 3:00 PM CDT.

Prior art rejections

Claims 66-71 and 73-84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent number 6,421,675 to Ryan, et al. ("Ryan") in view of U.S. patent number 6,289,341 to Barney ("Barney"). Claims 67, 72-74 and 80-82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan and Barney and further in view of U.S. patent no. 6,078,916 to Culliss ("Culliss").

The claimed method and apparatus relate to recommending search terms to a new information provider

In response to Applicant's argument that "the present invention defined by claims 66-83 provides a method and apparatus for recommending search terms to a new information provider, i.e., one who has not previously stored search terms on the database or associated search terms with himself," the Examiner asserts that the term "new information provider" is not described in the specification.

Applicants acknowledge that the terminology "new information provider" is not directly in the specification. However, at page 38, lines 14-16, FIG. 10 is described as "a flow diagram illustrating a method for recommending search terms to an advertiser on a pay-for-placement search engine. On the same page at lines 24-25, it is stated that "In block 1002, the system prompts the advertiser to choose an input method to create *the initial list of accepted search terms*" (*emphasis added*). This method is explained in light of a problem to be solved by the invention, detailed at page 2, lines 29-30: "Unfortunately, few advertisers understand *how to create a good list of search terms*, and right now there are only limited tools to help them" (*emphasis added*).

The terminology “new information provider” was added to claims 66-84 to clarify this problem and solution. The method applies to a system in a computer network search apparatus (preamble of claim 66). The apparatus includes a computer system, a database storing items of information and which are associated with a search term and an information provider (preamble of claim 66). When “a new information provider who is adding items to the database” (element (a) of claim 66) accesses the database, the method steps may be performed.

Thus, while the claim language should be interpreted in light of the specification and claim language should be given its broadest reasonable reading, when read in light of the specification including the Background defining the problem and the text describing the highest-level flow diagram (FIG. 10), it is clear that a “new information provider is an information provider joining the computer network search apparatus as an information provider who has not previously stored search terms on the database or associated search terms with himself.

The “new information provider” of claim 66 is an advertiser or other individual and his computer system, not a search engine.

The Examiner has considered the claim language and Ryan and concluded that the “new information provider” recited in claim 66 reads on the search engine disclosed by Ryan. It is respectfully submitted that a new information provider in the context of claim 66 is an individual (and his computer system), not a search engine. The present application, at page 10, lines 24-31 explains:

For example, one class of users located at client computers 12 may be **network information providers** such as advertising web site promoters or owners having advertiser web pages 30 located on advertiser web servers 14. These advertising web site promoters, or advertisers, may wish to access account information residing in storage 32 on account management server 22. An advertising web site promoter may, through the account residing on the account management server 22, participate in a competitive bidding process with other advertisers.

(emphasis added). Thus, the parties involved with the system recited in method claim 66 include a user who enters information through an input device and information providers which are

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associated with items stored in the database. A new information provider is one who has not previously stored search terms on the database.

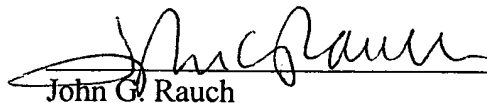
Once the parties are more clearly identified, it becomes apparent that Ryan actually relates to a search system which provides keyword suggestion to a user of the search system. From column 5, line 13, a keyword is "the word or phrase that the user enters to find a list of web pages." The search process is described at column 4, lines 30-40. The system suggests keywords to the user, based on a keyword that the user entered. Column 7, lines 63-66; column 8, lines 28-32.

Since the keywords are suggested to the user, Ryan fails to disclose the present invention of claims 66-84 which relates to suggesting keywords to an information provider, as that term is used in the present application. Information providers are present in the Ryan system, e.g., FIG. 1B "Developer site/computer" 104A, B; column 4, lines 3-11. However, Ryan's keyword suggestion feature serves the user who submits search requests, not the developer who provides content and other information.

While only portions of claim 66 have been discussed in detail herein, it is submitted that independent claim 79 includes similar limitations and is allowable for the same reasons. Withdrawal of the rejections of claims 66-84 is respectfully requested.

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,



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